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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/897,826	07/03/2001	Stephen Michael Reuning	Diedre/Candidate	3851

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EXAMINER	
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2175	15

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Commissioner for Patents

See Enclosed Examiner's Answer

Sam Rimell
Primary Examiner
Art Unit: 2175

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BEFORE THE BOARD OF PATENT APPEALS AND INTERFERENCES

Paper No. 15

Application Number: 09/897,826
Filing Date: July 03, 2001
Appellant(s): REUNING, STEPHEN MICHAEL

Mark Pohl
For Appellant

EXAMINER'S ANSWER

This is in response to the appeal brief filed October 24, 2003.

(1) Real Party in Interest

A statement identifying the real party in interest is contained in the brief.

(2) Related Appeals and Interferences

A statement identifying the related appeals and interferences which will directly affect or be directly affected by or have a bearing on the decision in the pending appeal is contained in the brief.

(3) Status of Claims

The status of claims are that claims 1-19 are pending.

(4) Status of Amendments After Final

No amendment after final has been filed.

(5) Summary of Invention

Appellant's summary of the invention is a summary of the prosecution history of the present application. A concise summary of the invention can be obtained from reviewing pages 5-7 of appellant's original specification.

(6) Issues

Appellant's statement of issues is argumentative. The application is on appeal for consideration of one issue: Whether claims 1-19 are properly rejected under 35 USC 102(e) as being anticipated by McGovern et al.

(7) Grouping of Claims

The rejection of claims 1-19 under 35 USC 102(e) as being anticipated by McGovern et al. stand or fall together because appellant's brief does not include a statement that this grouping of claims does not stand or fall together and reasons in support thereof. See 37 CFR 1.192(c)(7).

In particular, appellant provides no reasons for individual consideration of each claim or arguments in support of patentability for each individual claim.

(8) Claims Appealed

The copy of the appealed claims contained in the Appendix to the brief is correct.

(9) Prior Art of Record

U.S. Patent 6,370,510 to McGovern et al., published April 9, 2002, priority to earlier application dated May 8, 1997.

(10) Grounds of Rejection

Claims 1-19 are rejected under 35 U.S.C. 102(e) as being anticipated by McGovern et al. (U.S. Patent 6,370,510).

Claim 1: McGovern et al. discloses a system in which job seekers voluntarily submit resumes to a company web site and which is subsequently stored in a company database (col. 17, lines 23-23). The resume is considered to be a web page by reason that it is converted into HTML format before storage in the company database (col. 17, line 16) and by additional reason that the resume can be displayed on program running on a web browser (col. 7, lines 5-10).

The system of McGovern et al. discloses a filter (col. 18, lines 51-67) in which a company employee (the hiring contact) can use a filtering program (search program) to search for specific resumes in the database. The resumes can also be scored (col. 17, lines 59-66), which acts and another type of filter mechanism.

The system of McGovern et al. further discloses an e-mail address extractor (col. 18, lines 24-35) in which the company computer will extract an e-mail address from its database and use that address to send correspondence to the job applicant who submitted the resume. The e-

mail address is extracted from the resume database because the applicant does not have to submit the resume using e-mail, or in any kind of e-mail format (col. 17, lines 18-23).

Claim 2: The resumes are web pages and the web pages can be scored (col. 17, lines 60-65).

Claim 3: The company computer is configured to send an e-mail to the job candidate who submitted the resume (col. 18, lines 30-35).

Claim 4: The system can generate a score for the resume (col. 17, line 60). Any job applicant can receive an e-mail (col. 18, lines 24-35). A job candidate that scores low can receive a rejection letter while a job candidate who scores high can receive a job offer.

Claim 5: The e-mails sent to the job candidates pertain to the job opportunity.

Claim 6: See remarks for claim 1.

Claim 7: See remarks for claim 3.

Claim 8: See remarks for claim 5.

Claim 9: The e-mail addresses are extracted from the resume data in the database. The is considered to read as one level of extraction.

Claim 10: The system of McGovern et al. has two filtering mechanisms, one for searching resumes using keywords (col. 18, lines 51-67) and one for filtering by scoring (col. 17, lines 60-66). The mechanism using keyword searching meets the limitations of this claim.

Claim 11: Keyword searching is considered to be an "advanced natural language screening technology".

Claim 12: Key word searching inherently involves the usage of rules to evaluate the searched documents.

Claim 13: See remarks for claim 1.

Claim 14: See remarks for claim 3.

Claim 15: See remarks for claim 5.

Claim 16: See remarks for claim 9.

Claim 17: See remarks for claim 10.

Claim 18: See remarks for claim 11.

Claim 19: See remarks for claim 12.

(11) Response to Argument

Affidavit under 37 CFR 1.131: Appellant argues that the reference to McGovern et al. has already been antedated by a submission of an affidavit under 37 CFR 1. 131 in the parent application 08/984,650, which matured into US Patent 6,381,592. Appellant states that the Examiner did not object to the affidavit in the parent application, and thus it must be inferred that the Examiner in the parent application found the affidavit to be effective, and that such an inference must also be carried over into the present application.

Examiner maintains that the alleged actions or inactions by a previous examiner in a patent are not at issue since they cannot be considered or addressed. In particular, MPEP 1701 states:

> "Employees of the USPTO, particularly patent examiner who examined an application which matured into a patent or a reissued patent or who conducted a re-examination proceeding, should not discuss or answer inquiries from any person outside the USPTO as to whether or not a certain reference or other particular evidence was considered during the examination or proceeding and whether or not the claim would have been

allowed over that reference or other evidence had it been considered during the examination or proceeding"(emphasis added).

In essence, appellant is asking the Examiner to draw an inference about the Examiner's actions in the parent application and apply those inferences in the present case. Examiner maintains that under MPEP 1701, such inferences cannot be made. The Examiner cannot go back into the file history of a patented parent application and re-interpret the Examiner's intentions. In considering an affidavit under 37 CFR 1.131, the affidavit must be considered on its own merits in light of the claims currently under examination. Such affidavit cannot be examined in light of inferences drawn from another patented application.

Analysis of Affidavit under 37 CFR 1.131: Examiner has analyzed the affidavit under 37 CFR 1.131 and finds that the conception is not correlated to the claims of the present application. In other words, while the affidavit does allege a specific date of conception, the subject matter which was conceived on the conception date cannot be correlated to the current claims on appeal. As result, the affidavit under 37 CFR 1.131 is inconclusive in a determination of whether or not the claimed invention was conceived at date prior to effective filing date of McGovern et al. Since the affidavit is inconclusive in this particular analysis, it is not effective in overcoming the McGovern et al. reference.

Rebuttal of arguments pertaining to McGovern et al.: Appellant argues that McGovern et al. lacks: (1) a filter for searching a web page; and (2)an e-mail address extractor. Appellant also alleges that examiner did not assert that McGovern et al. has such features. Both arguments are incorrect. McGovern et al. discloses a filter at col. 18, lines 51-67 which takes the form of a search program to search for specific resumes in a database. The resumes are considered to be

searchable web pages by reason that they are converted into HTML format before being stored in the database and additionally because they are displayed on a web browser (col. 17, line 16 and col. 7, lines 5-10 respectively). Both of these arguments are explicitly raised in the office action. In addition, McGovern et al. discloses an e-mail extractor at col. 18, lines 24-35. The e-mail address is extracted from the database and used to automatically create a recipient address without performing this function manually. This feature is also explicitly addressed in the office action.

Issue of estoppel: Appellant argues that the examiner is estopped from applying the McGovern et al. reference. The rationale for estoppel is based on the statements of appellant that the McGovern et al. was raised during the prosecution of the parent application and rebutted without traverse from the examiner in the parent application. Since the appellant is stating that the examiner did not make traverse of the arguments, the arguments must be inferred as having been accepted. Once again, appellant is asking that inferences be made about the prosecution history of the parent application. Examiner maintains that under MPEP 1701, no such inferences can be drawn. Neither appellant nor the present examiner can infer the examiner's opinions or intentions during the prosecution of the patented parent application. Such arguments cannot be considered. Furthermore, there is no basis in law or regulation for estoppel of the examiner's action in the continuation application of a utility application.

Issue of collateral estoppel: Appellant alleges that an issue of collateral estoppel arises in the present application. This issue is discussed in MPEP 2012.01, where it is stated that collateral estoppel applies in a reissue of a patent which has been held invalid. MPEP 2012.01 also recites the *Blonder-Tongue Labs, Inc. v. Univ. of Ill. Found.*, 402 U.S. 313, 169 USPQ513 (1971) which

is also recited by appellant. However, the present application is not a reissue application and applicant's parent application, based on the information available in the record, has not been adjudicated as invalid. Accordingly, no issue of collateral estoppel exists in the present application.

Rejections under 35 USC 112: All previous rejections under 35 USC 112 have been vacated.

For the above reasons, it is believed that the rejections should be sustained.

Respectfully submitted,

Sam Rimell
Primary Examiner
Art Unit 2175

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January 22, 2004

Conferees
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